

Group II - Claims 17-24, drawn to a method for preventing degradation of cartilage tissue in an animal comprising administering to said animal a cartilage degradation effective amount of at least one glycine and proline, classified in class 514, subclass 474.

Group III - Claims 25-33, drawn to a composition suitable for systemic administration to an animal comprising a cartilage strength enhancing effective amount of at least one glycine and proline in association with a carrier, classified in class 514, subclass 474

Applicants respectfully traverse this restriction requirement. However, to have a complete response to this Office Action, applicants provisionally elect with traverse Group II, claims 17-24, for prosecution on the merits.

The Examiner states that the inventions are distinct, each from the other because of the following reasons:

Inventions I and II are directed to related distinct processes. The related inventions are distinct if the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 806.05(j). In the instant case, proline and glycine can be used to form new cell and contribute to the maintenance of the skin (see enclosed abstract).

Inventions I and III and inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, proline and glycine can be used to form new cell and contribute to the maintenance of the skin (see enclosed abstract).

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, divergent subject matter restriction for examination purposes as indicated is proper.

Groups I and II

The Examiner asserts that the inventions in Groups I and II are related as distinct processes. However, MPEP §806.05(j) permits the applicants to claim two related process inventions unless the Examiner can show both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status in the art, or field of search.

However, the reasoning given by the Examiner does not establish distinctness. The invention in Group I and Group II are not in a separate classification and they have the same or similar status in the art. Further, the inventions would not require separate searches to evaluate patentability. A method of increasing the flexibility of cartilage and a method for preventing degradation of cartilage are closely so closely related that a search would by necessity reveal the same prior art. Certainly, the inventions overlap in scope.

In addition, assuming proline and glycine can be used to form new cell and contribute to the maintenance of the skin, the Examiner should not be permitted to select any possible use for the compounds and assert a restriction requirement. Glycine and proline can be used as supplements. However, this should not mean that all new uses for these compounds should be distinct. Certainly, a method of increasing the flexibility and a method for preventing degradation of cartilage are not distinct. The claims as written are consistent with what is permitted in MPEP §806.05(j).

Since it is clear that the Examiner has not given a feasible reason for restricting Group I and Group II or, even assuming the reason is considered feasible, it has been rebutted, the restriction requirement should be withdrawn. Therefore, since the Examiner has not shown that the inventions are distinct, applicants respectfully request that the restriction be completely withdrawn.

Groups I and II and Group III

As stated by the Examiner, the inventions in Groups I and II and the inventions in Group III are related as a product and process for its use. However, MPEP §806.05(h) permits the applicants to claim a product and a process for using that product. This is permissible unless the Examiner provides an example of practicing the process with another product or using the product with another process. The Examiner's example is one that does not distinguish the product and its use. The Examiner states that "proline and glycine can be used to form new cell and contribute to the maintenance of the skin." This may be true but the example is not

consistent with applicant's claims. The Examiner is not permitted to select any possible use for the product, e.g., a doorstop or a nutrient, and assert that the product can be used in a different process. The use must be consistent with reason and applicant's invention. Almost any product can have a different use, e.g., proline can be used as a dietary supplement. Applicant claims methods for increasing the flexibility and preventing degradation of cartilage. Groups I + II and Group III are merely the amino acids and the use of such amino acids to affect cartilage. The claims as written are consistent with what is permitted in MPEP §806.05(h), particularly since the Examiner offered no credible use for the product that relates to the invention.

Since it is clear that the Examiner has not given a feasible example or, even assuming the example is considered feasible, it has been rebutted, the restriction requirement should be withdrawn. Therefore, since the Examiner has not shown that the inventions are distinct, applicants respectfully request that the restriction be completely withdrawn.

The Election of Species Requirement

The Examiner has further required an election of species. Applicants respectfully traverse this election requirement. However, to have a complete response to this Office Action, applicants provisionally elect with traverse the species proline in Group II, claims 17-24.

The Examiner has given no reason for requiring an election of species and has not indicated what the Examiner considers a genus or species. However, although glycine and proline are different compounds, they are both amino acids. A search for one species in the Group will suffice for the other species in that group since they are both common amino acids that are classified together. The election requirement is therefore improper and should be withdrawn.

Since the Examiner has not shown that the inventions should be restricted or that a species should be elected, applicants respectfully request that the restriction and election requirements be completely withdrawn.

Respectfully submitted,


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